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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,116	07/26/2001	Bruce E. Price	RGP-0062	8624

23413 7590 09/30/2005  
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EXAMINER

CHANG, VICTOR S

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/916,116

Applicant(s)

PRICE ET AL.

Examiner

Victor S. Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/15/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' IDS, amendments and remarks filed on 9/15/2005. Applicants' amendments to claims 1, 5-7, 13, 17 and 34-37.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-19 and 34-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, Applicants have amended the claims to change all the terms "anchoring layer" to "polymer layer", and fail to provide a support in the original specification. Since such an amendment clearly changes the scope of the instant

invention, and appears to be new matter, Applicants are required to either provide a clear support in the specification in the next reply, or cancel the new matter.

6. Claims 1-4, 6-12, 17-19, 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the independent claims, have been amended to recite, *inter alia*, "... a polymer layer that prevents cohesive failure of the reinforcing film ...". However, it should be noted that claims merely setting forth physical characteristics desired in article, and not setting forth specific structure and/or compositions which would meet such characteristics, either in the claim or specification, are invalid as vague, indefinite, and functional, since it recites compounds by what it is desired that they do rather than what they are, and resulting in a claim scope that is indefinite since one of skill in the art is unable to determine without undue experimentation what compounds are included or excluded therefrom. As such, it is unclear as to what is the scope of the invention of which Applicant intends to claim. *Ex parte Slob (PO BdApp)* 157 USPQ 172.

### ***Rejections Based on Prior Art***

7. Claims 1-19 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admission in view of Birchall et al. (US 3839078), substantially for the reasons set forth in section 5 of Office action mailed 7/16/2004, together with the following additional reasoning and response to argument.

First, for the purpose of clarification, the Examiner repeats the relied upon prior art as follows: Applicants have acknowledged in the specification that it is known art that flexible foam tapes are commonly used in flexographic printing, and these tapes, commonly referred to as foam cushion tapes, comprises a flexible compressible foam layer adhered to one side of a reinforcing film, with a second adhesive layer disposed on the opposite side of the film. It should be noted that the phrase "second adhesive layer" implies that the flexible compressible foam layer is adhered to one side of a reinforcing film with a "first adhesive layer". An adhesive layer is furthermore disposed on the outside of the foam layer. The tapes are typically made in the thickness of 15 to 60 mil (pages 1-2, bridging paragraph). Regarding the materials and process of making the foam cushion tapes, Applicants also acknowledged that typically they are manufactured by laminating a cast foam layer (polyethylene, ethylvinyl acetate, polyvinyl chloride, or polyurethane) to one side of a one-mil polyethylene terephthalate (PET) film (i.e., reinforcing layer) using an adhesive (i.e., the implied first adhesive layer), and the second adhesive layer is disposed between the PET film and a release layer. Further, it is known that, after use, the PET reinforcing film may delaminate from the foam during removal of the printing plate from a used tape (page 2, first full paragraph).

For claims 1-3, 5, 6, 10 and 34, it is noted that the acknowledged prior art lacks a teaching of the composition of the anchoring layer. However, it is noted that Birchall's invention is directed to a method of coating substrates (Abstract). Birchall teaches that it has been a common practice to coat a surface of a film substrate with one or more

adhesion promoting layers which adhere to the film substrate and to which the superstrate (coating) readily adheres. Such intermediate coating layers are often referred to as anchor coatings and are derived, for example, from an isocyanate-ended polyurethane resin, a phenol-formaldehyde resin or a vinylidene chloride - alkyl acrylate copolymer resin (column 21, line 61 to column 22, line 14). Suitable film substrates are polymeric films such as PET films (column 8, line 60), and examples of coatings (superstrates) include polyurethanes, etc. (column 14, line 53 to column 15, line 4). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify Applicants' admitted prior art by incorporating a commonly practiced anchor layer of isocyanate-ended polyurethane or vinylidene chloride - alkyl acrylate copolymer between the reinforcing PET film substrate and the polyurethane foam layer, motivated by the desire to obtain a strong adhesion between the polyurethane and PET layers, as a common practice to one skilled in the art of polyurethane and PET laminates. In particular, it should also be noted that since the acknowledged prior art is not particular to adhesive type, it would be obvious to one of ordinary skill in the art to select an appropriate material from a known conventional art which promotes a strong adhesion between polyurethane and PET layers, such as the inherently adhesive "anchor layer" taught by Birchall, to form the laminate. Additionally, it should be noted that Birchall's isocyanate-ended polyurethane or vinylidene chloride - alkyl acrylate copolymer read on the generic materials of the instantly claimed anchor layer of polyurethane and polyvinylidene chloride as claimed, and they are also inherently polymeric materials. Finally, regarding the functional limitation "... a polymer

layer that prevents cohesive failure of the reinforcing film ...”, the Examiner asserts that, in the absence of evidence to the contrary, since the composition of Birchall’s anchor layer reads on the polymer layer as claimed, such function are inherent property of Birchall’s anchor layer.

For claim 4, the Examiner’s statement “the polyurethane foams used in flexographic printing are inherently open-celled” in the in the prior Office action dated 10/25/2002 is taken to be admitted prior art because Applicants failed to traverse the Examiner’s assertion.

For claims 7 and 35, regarding the product-by-process recitation “... film is formed by co-extrusion”, the Examiner notes that since the method limitations have not been shown on the record to produce a patentably distinct article, the formed articles are rendered *prima facie* obvious. It should be noted that Applicants have not traversed Examiner’s position.

For claims 8, 9, 11 and 12, the Examiner notes that the common knowledge or well-known in the art statement “acid etching a polymer surface for improved adhesion, applying a primer layer between an adhesive layer and a foam substrate layer, and attach a release layer made of a release coating, an intermediate layer, and a liner to protect the adhesive layer are each common and well-known” in the prior Office action dated 10/25/2002, page 4, last full paragraph, is taken to be admitted prior art because Applicants have failed to traverse the Examiner’s assertion.

For claims 13-19, 36 and 37, it is noted that the claims are within the same scope of instantly claimed elements and limitations as claims 1-12. As such, they are also rejected for the same reasons as set forth above.

### ***Response to Argument***

8. Referring the newly amended claims, which changes the term "anchoring layer" to "polymer layer", Applicants' argument "Birchall fails to provide a motivation to use a polymer layer between the claimed polyurethane foam and composite reinforcing film ... to improve the cohesive strength of the reinforcing film, and fails to provide any expectation of success in so doing. As stated in the specification, and shown in the Declaration of Brett Kilhenny dated July 3, 2003, failure of the claimed foam cushion tapes upon removal from a drum is not due to insufficient adhesion between the polyurethane foam and the composite reinforcing layer. The failure is due, instead, to weak cohesive strength at the surface of the reinforcing layer itself" (Remarks, page 8, first and second paragraphs) has been carefully considered, but is not persuasive. The Examiner repeats that since the acknowledged prior art is not particular to adhesive type, it would be obvious to one of ordinary skill in the art to select an appropriate material from a known conventional art which promotes a strong adhesion between polyurethane and PET layers, such as the inherently adhesive "anchor layer" taught by Birchall, to form the laminate, and Birchall's inherently polymeric isocyanate-ended polyurethane or vinylidene chloride - alkyl acrylate copolymer read on the generic materials of the instantly claimed anchor layer of polyurethane and polyvinylidene



chloride as claimed. Finally, regarding the declaration of Brett W. Kilhenny, the Examiner repeats that Appellants' argument and declaration fail to provide any direct or indirect evidence for unexpected results which must be evidenced by comparing with the closest prior art of Birchall (see Office action dated 7/16/2004, page 5). In particular, since Appellants' evidence (cohesive failure of PET film) is irrelevant to the thrust of the rejection, i.e., the acknowledged prior art in view of Birchall renders the instant invention obvious, and the evidence merely appears as a recognition of latent properties in the prior art of Birchall, which teaches the adhesion promoting "anchor layer" between a polyurethane coating (superstrate) and a PET film (substrate) as claimed, it does not render nonobvious an otherwise known invention. See MPEP 2145, II.

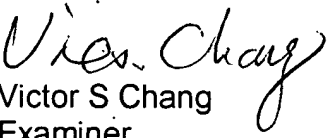
### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

9/27/2005